

2008-1461
(SERIAL NO. 09/871,349)

In The
United States Court of Appeals
For The Federal Circuit

IN RE PAUL J. BRYAN

APPEAL FROM THE
UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

APPELLANT'S CORRECTED REPLY BRIEF

Mr. Paul J. Bryan, *pro se*
413 East Millbrook Road
Raleigh, NC 27609
(919) 248-5137

TABLE OF CONTENTS

Table of Authorities	ii
I. Introduction	1
II. The PTO fails to contest the claim construction issue dealing with the proper sequence of claim construction and application of the printed matter doctrine	2
III. The PTO's application of the "functional relationship" test is too narrow	3
IV. Contrary to the PTO's Brief, the Board's conclusion that there is no functional relationship between the printed matter and substrates is not supported by substantial evidence.....	5
A. The Board failed to even consider the function of the substrates	5
B. Mr. Bryan's Declaration Establishes that There is a Functional Relationship Between Printed Matter and the Substrates	8
C. The Board's Decision is Contrary to the Authority Cited by the PTO	9
V. Applicant's Game Apparatus is New and Nonobvious Over <i>Elrod</i>	12

TABLE OF AUTHORITIES

<i>In re Gulack</i> , 703 F.2d 1381 (Fed. Cir. 1983).....	3, 22, 23, 24, & 25
<i>In re Lowry</i> , 32 F.3d 1579 (Fed. Cir. 1994)	9
<i>In re Miller</i> , 418 F.2d 1392 (CCPA 1969)	11
<i>In re Ngai</i> , 367 F.2d 1336, 1339 (Fed. Cir. 2004).....	10, 11, & 17

I. Introduction

If the PTO arguments are correct, the prospect for patenting most game apparati, no matter how novel and non-obvious, is bleak. After all, it is often the printed matter that makes a game apparatus novel and non-obvious, and it is the printed matter that gives purpose and function to the structural elements of the game apparatus. Take away the printed matter and most game apparati are reduced to game boards, decks of cards, and other known elements.

Even though the printed matter doctrine may stand on questionable legal and logical footing, Applicant recognizes the traction that the printed matter doctrine has gained recently. The liberal application of the printed matter doctrine, however, in game apparati cases is concerning. A superficial or liberal application of the printed matter doctrine carries the danger of practically eliminating many game apparati from the classes of statutory subject matter.

Here the PTO argues that giving patentable weight to printed matter is acceptable when the underlying substrate is transformed or where the actual character of the substrate is changed. [PTO's Brief pp. 14-18.] It is not exactly clear what this means. But if an actual transformation or change in character is required, rarely will printed matter have such an

impact. Where the transformation or character change test is not met, the tendency of the Patent Office is to characterize claimed printed matter as merely conveying information. Between these two extremes there is a wide area where a functional relationship between printed matter and the underlying substrate can exist. Here, printed matter is doing much more than merely conveying information, but it may be difficult in a strict literal sense to say that the printed matter transforms the underlying substrate. The printed matter on the Band Member cards, for example, does not transform the cards into a different structure, but the printed matter does import functionality to the cards and indeed it is the printed matter that enables the Band Member cards to function in the claimed invention.

II. The PTO fails to contest the claim construction issue dealing with the proper sequence of claim construction and application of the printed matter doctrine.

The Examiner excised the printed matter limitations from the claims and then proceeded to construe the claims. This was affirmed by the Board. [Applicant's Brief pp. 23-33.] This is reversible error. Surprisingly, the PTO's Brief does not address this issue, nor does the PTO even argue that claim construction and the printed matter analysis was properly sequenced. The PTO's failure to contest or even address this issue should

be taken as a concession that printed matter was excised from the claims, and that the claims were thereafter construed.

This assignment of error is not merely an academic exercise, nor is the error harmless. Claims should always be construed as a whole, and construed before any type of analysis is performed. Otherwise the claim construction is flawed and so is the resulting analysis. When printed matter is excised from claims and the claims are then construed, as happened here, then clearly the claims as a whole are not construed. Under this approach it is difficult to see how the Examiner could have completely and objectively determined if there was a functional relationship between the printed matter and the substrate.

III. The PTO's application of the "functional relationship" test is too narrow.

As the PTO's Brief points out, case law applying the printed matter doctrine is limited. However, the test that has been set forth by this court is clear. In *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983), the court held that the critical question in a printed matter case is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. Thus, the initial question is whether there exists a functional relationship between the printed matter and the substrate.

In its brief, the PTO seems to require more than a functional relationship in order for the printed matter to be given any patentable weight. [PTO's Brief, pp. 14-18.] The central argument of the PTO is that in order for there to be a functional relationship, there must be something on the order of a physical transformation of the substrate, or at least a change in the character of the substrate. *Id.* Certainly, physical transformations and character changes would qualify as a functional relationship. However, these are rare and other forms or types of functional relationships can exist which may not involve a physical transformation or a basic change in the nature and character of the substrate.

The rule of law here simply requires a functional relationship, and that basic test has not been qualified to require physical transformations or character changes of the substrate. The test should be that a functional relationship exists if the printed matter on the substrate imparts functionality to the substrate or makes the substrate functional in the context of the claimed invention.

IV. Contrary to the PTO's Brief, the Board's conclusion that there is no functional relationship between the printed matter and substrates is not supported by substantial evidence

A. The Board failed to even consider the function of the substrates.

Absent in the PTO's Brief is a discussion of how the Board analyzed the functional relationship question. The PTO's Brief simply repeats the Board's conclusionary finding: "the indicia was simply information conveying intelligence to the reader." [PTO Brief pp. 18-19.] The Board failed to even consider the function of the various substrates and the PTO's Brief fails to address the function of any of these substrates. It is impossible to determine if a functional relationship exists between the printed matter and the Band Member cards, for example, without looking at the function of the Band Member cards. Viewing the printed matter in a vacuum without considering the function of a substrate, says nothing about any functional relationship that may exist between the printed matter and the substrate. Nowhere in the Board's decision is there a discussion or even an acknowledgement of the function of the Band Member cards, for example. Instead the Board repeatedly concludes that the printed matter merely conveys information. Again, that does not address the printed matter test, which looks to determine if there is a functional relationship between the printed matter and an underlying substrate. After all, most

printed matter conveys information. The Board's finding of no functional relationship is not supported by substantial evidence if the Board did not consider the function of the Band Member cards, for example, and how the printed matter on the Band Member cards impacts the functionality of the Band Member cards.

Nowhere in the Board's decision is there any indication that the Board considered the function of the Band Member cards, for example. Indeed the Board's analysis stopped at the printed matter. Simply, the Board viewed the printed matter on the Band Member cards and concluded that the printed matter merely conveyed information. Interestingly, the Board made the observation that "it is of no consequence that the information on the card may be functionally related to the method of playing the game, as claim 1 is an apparatus claim and recites no functional method steps of playing the game which functionally used the indicia." [A. 8.] The Board is likely acknowledging that the printed matter is at least functionally related to playing the game. If that is true and the substrate carrying the printed matter is used in playing the game, then that indicates the printed matter is functionally related to the substrate.

As discussed in Applicant's Opening Brief, and as discussed herein, there is a functional relationship between the printed matter and substrates.

In the case of the Band Member cards, they function as collectible cards.

[A. 22 – 23.] They are collected by the players. Printed matter divides the Band Member cards into a series of different band groups, the printed matter enables the Band Member cards to be collected, and through drawing and player exchanges the printed matter enables a player to eventually collect one particular group of cards from the entire deck which includes a series of different groups.

In Applicant's game apparatus, the specific printed matter on each of the Band Member cards forces the substrate to take an action; this action transforms the collective substrates into the plurality of predetermined groups of collectible Band Member cards. Even while the substrates are being shuffled, the printed matter on the Band Member cards constantly divides the substrates into a plurality of predetermined groups of collectible Band Member cards. Together the substrate and the printed matter give the card an individual identity. The substrate shields the identity of the band member printed on the substrate from the opposing players and the substrate enables the printed matter to be traded and blind drawn between players, and in turn this enables both the substrate and the printed matter to become part of the game apparatus. In Applicant's game apparatus, the plurality of predetermined groups of collectible Band Member cards is a

functioning apparatus on its own, with the substrates constantly dividing themselves, yet this apparatus is only one element of a larger apparatus which involves the layout of the pathways as well as the deck of Consequence cards and the deck or series of Band Equipment cards.

B. Mr. Bryan's Declaration Establishes that There is a Functional Relationship Between Printed Matter and the Substrates.

The Board and the PTO's Brief ignore the testimony of Mr. Bryan. The PTO's Brief characterizes Mr. Bryan's testimony as argument and deems it unpersuasive. The Board never seriously considered Mr. Bryan's testimony. It mentions Mr. Bryan's Declaration at only two places in its decision. [A. 7 & 12.] Contrary to the PTO's Brief and the Board's decision, Paragraph 8 of the Declaration, for example, establishes a functional relationship between the printed matter and the Band Member cards. [A. 138.] The statements made in this paragraph are facts and not opinions. The testimony here is certainly a more in-depth analysis of the relationship between the printed matter and the substrate than is found in the Board's decision.

The PTO's Brief attempts to justify ignoring the Declaration by maintaining that Mr. Bryan's testimony misconstrues the printed matter doctrine. Applicant respectfully disagrees. While the testimony in Paragraph 8 may not completely discuss all of the functional relationships,

the Declaration certainly establishes that the functionality of the Band Member cards is impacted by the printed matter which divides the Band Member cards into separate and distinct sets or groups. That is critical to the functionality of the cards because the cards cannot be collected and perform their intended function unless the printed matter is present.

C. The Board's Decision is Contrary to the Authority Cited by the PTO

The PTO's Brief reviews a number of printed matter cases and attempts to argue that the Board's decision is consistent with these cases. [PTO's Brief, pp. 14-18.] In one instance, *In re Lowry*, 32 F.3d 1579 (Fed. Cir. 1994) is discussed. The PTO argues that *Lowry* stands for the proposition that a printed matter is excluded when it only defines, as in the invention, certain novel arrangements of printed lines or characters. That is not the case here. Applicant is not claiming any arrangement of printed lines or characters. What is claimed here, is a means that in the case of the Band Member cards, for example, enables the Band Member cards to be collected and function as intended. While most printed matter conveys information, that is not the primary purpose of the printed matter of Applicant's game apparatus as implicated by the claims. The primary purpose of the printed matter is to impart functionality to the various elements of the game apparatus.

The PTO argues that there is a distinction between printed matter that simply conveys intelligence and printed matter that “interacts” with the article to transform the article into a product with a new and different function. [PTO Brief, p. 16.] The proffered test requiring interaction is questionable. It is not clear where the PTO finds authority for this test because case law holds that only a functional relationship is required. In terms of function, the Band Member cards have no function without the printed matter. Hence, the printed matter causes the Band Member card to have a different function from the function they would have in the absence of the printed matter.

The PTO also relies on *In re Ngai*, 367 F.2d 1336, 1339 (Fed. Cir. 2004). *Ngai* involved a claim to a kit that included an instruction sheet in the kit. This Court held that the instruction sheet was printed matter not functionally related to a substrate. It is difficult to see how *Ngai* can be analogized to the present case. In *Ngai*, the instruction sheet was simply that – a sheet of instructions. The sheet of instructions did not form a part of any of the elements or substrates of the kits. In Applicant's claimed invention, the printed matter is not an instruction sheet separated from the elements of the game apparatus. The printed matter forms a part of the

substrates and imparts functionality to the various substrates or elements claimed.

The Court in *Ngai* set out what may be termed the “dependency” test to determine if printed matter is functionally related to a substrate. *Ngai* held that the printed matter, or the instruction sheet, in no way depends on the kit and the kit does not depend on the printed matter. [PTO’s Brief p. 16.] However, here the substrates do depend on the printed matter. The game apparatus is nonfunctional without the printed matter. The Band Member cards totally depend on the printed matter. Take away the printed matter from the Band Member cards, for example, and the Band Member cards fail to have any utility and fail to function. Accordingly, the entire claimed game apparatus fails to have utility or function. That is dependency.

The PTO also cites *In re Miller*, 418 F.2d 1392 (CCPA 1969). In *Miller*, the claimed invention involved a measuring cup having indicia that enabled fractional recipes to be made. The CCPA determined that there was a functional relationship between the printed matter and the measuring cup. Printed matter did not transform the measuring cup. Even after adding the printed matter, the measuring cup remained a measuring cup. Admittedly, the indicia enabled the measuring cup to measure ingredients

for fractional recipes. Thus, there was a functional relationship between the printed matter and the measuring cup. This is not unlike the present case. Printed matter does not change a card into another structure, but it enables the card to perform a function that it otherwise could not.

V. Applicant's Claimed Game Apparatus is New and Nonobvious Over *Elrod*

The PTO states: "The Board found that these various categories of cards, all disclosed in *Elrod*, meet the identification of Consequence, Band Member and Band Equipment cards in claim 1." [PTO's Brief, p. 8.] The Board's findings are based on the Examiner's flawed argument. The Examiner states:

The only difference between applicant's game (cards, game path) and *Elrod* game (cards, game path) resides in meaning and information conveyed by the printed matter and would not be patentable difference. For example *Elrod* cards (co. 8, lines 7 – 34) asking the name of a band/artist can be interpreted as applicant's "band member card" or "band equipment card." The examiner takes the position that the term "artist" on *Elrod* cards can be read as "band member" and the term "band" can be read as "band equipment." These differences in the printed matter are only in meaning and information conveyed and not in the game. The teachings provided by the cited court opinions are source of motivations in the obvious rejection.

[A.145.] This argument is flawed for two reasons. First, the *Elrod* cards are neither the element of a Band Member card nor the element of a Band

Equipment card. [A.30.] They are a Questions and Answers card, and can only be interpreted as cards which ask a question and demand an answer, and then reward or penalize the player with a monetary value. Second, this finding ignores the fact that in Applicant's invention, the Band Member cards, the Band Equipment cards, the Consequence cards, and the layout of the pathways are interrelated in a functional way, which is completely absent from *Elrod*.

On the surface it may seem as if *Elrod* contains the same elements as Applicant's claimed invention, but that is deceptive. Applicant's claimed invention is a functioning game apparatus which comprises of a plurality of predetermined groups of collectible Band Member cards which are one element of a larger apparatus. Both are absent from *Elrod*. This larger functioning game apparatus is created by the interrelated functionality between the elements and the layout of the pathways and placement of specific indicia on the game board. Applicant's claimed invention contains a series or "deck" of collectible Band Equipment cards, which is absent from *Elrod*. This is where the Examiner claims that he can interpret the term "band" to mean "band equipment" from the words "band/artist" on the *Elrod* Questions and Answers cards. [A. 30, 167.] In *Elrod*'s disclosures, it states "each band/artist may be named once only. Should a player announce the

name of a previously named group/artist during a turn, any opposing player can immediately challenge the error.” [A. 31.] Because *Elrod* substitutes the word “group” for the word “band,” it is clear that *Elrod* meant for the word “band” to mean “group” (Beatles, Rolling Stones, etc.), and not “band equipment” as the Examiner claims. The Examiner cannot interpret the term “band” to mean “band equipment” because *Elrod* meant for the term to mean “group.” *Elrod* only contains Questions and Answers cards and Consequence cards, even if these cards mention “band equipment” or “band member” in the wording of the Questions and Answers card or the Consequence card. There is no rational or coherent thought process which supports the Examiner’s argument that the *Elrod* cards constitutes both the element of the Band Member cards and the element of the Band Equipment cards. Therefore, the element of a series or deck of Band Equipment cards and the element of the Band Member cards is absent from *Elrod*.

The PTO states “The Board held that Elrod renders independent claims 1 and 11 obvious, and that Elrod and Hunsberger render dependent claim 6 obvious.” [PTO’s Brief, p. 8]. The Board’s decision is based on a flawed argument. When the element of the band members of *Elrod* are combined with the color-coding of *Hunsberger* and them compared to the

element of the Band Member cards of Applicant's invention, a person of ordinary skill in the art would realize that the two elements are different. When the color-coding of *Hunsberger* is combined with the *E/rod* cards "Name a band/artist whose first word begins with..." it will not yield the element of the Band Member cards of Applicant's invention. If the back of the card is color-coded, it will distinguish one deck of cards from another deck of cards and correspond to a space on the game board, whereas the *E/rod* cards are already distinguished from one another and correspond to a space on the game board. This adds nothing to the *E/rod* cards, and will not yield a Band Member card where the card and the printed matter together give the card an individual identity. The printed matter divides the cards into groups, where the substrate supports and presents the printed matter as part of a functioning structure, and the identity of the band member on the cards is shielded by the substrate from all opposing players. This is an essential element of Applicant's claimed invention. If the face of the *E/rod* card is color-coded, it will yield a question asked in different colors of ink, this will not change the question, nor will it change the nature of a Questions and Answers card. This will not yield the result of a Band Member card where the card and the printed matter together give the card an individual identity.

It is clear that the *Elrod* cards are not the same element as the Band Member cards of Applicant's claimed invention. *Elrod* also contains statuettes of band members which the players collect and insert into their tokens as the players advance around the game board. These statuettes are sold at the end of the game, and represent a monetary value of \$50,000; the player which accumulates the most money wins the game. Consider combining the color-coding of *Hunsberger* to the statuettes of *Elrod*, and insert the statuettes into the play of Applicant's claimed invention, and see if the color-coding of *Hunsberger* combined with the statuettes of *Elrod* could represent the same element as the Band Member cards of Applicant's claimed invention. Imagine having six players involved in the play of Applicant's claimed invention. Each player has an assortment of color-coded statuettes of band members. One of the players lands on a Consequence space, and draws the card "Crosstown Traffic." This Consequence card instructs every player to place two cards face down at the same time then trade one left and one right. [A. 41.] The reason why the cards must be face down is so that the substrate will shield the identity of the band member from all opposing players. This is essential because if the players know the identity of all opposing player's band members, the game apparatus will not function properly. When the six players place the

color-coded statuettes face down to comply with the Consequence card, all six players will see the identity of all the color-coded statuettes being traded, as well as the identity of all of the color-coded statuettes which all of the opposing players possess. If each player knows the identity of all opposing players' band members, no player would knowingly or willingly trade or give an opposing player the color-coded band member the opposing player needs to complete a band. It is at this moment, that a person of ordinary skill in the art realizes two things: First, the element of a Band Member card whose identity is shielded from all opposing players is absent in *Elrod*, even when the color-coding of *Hunsberger* is combined with *Elrod*. Second, unlike *Ngai*, where the printed matter in no way depends on the kit, and the kit does not depend on the printed matter, the printed matter depends on the substrate and the substrate depends on the printed matter.

At closer examination of *Elrod*, it is clear that every space on the game board and every card represent a monetary value or rescue a player from a monetary loss, and are functionally utilized for the sole purpose of the players to accumulate money. In the play of *Elrod*, the *Elrod* cards ask a question, if the question is not answered properly the player is penalized \$5,000, these cards have no other purpose or function. In the play of *Elrod*

the statuettes of the band members are sold for \$50,000 each. At the end of the game, the player with the most money wins. In *Elrod*, the statuettes are collected by the players, but simply represent a monetary value and have no other function. The game apparatus of *Elrod* is simple. Each player advances his token around the game board only once. The players collect statuettes of band members and accumulate money. When all players reach the final stage, the players sell the statuettes of band members for money, and the player with the most money wins.

The game apparatus of Applicant's claimed invention is designed around a functioning structure of a plurality of predetermined groups of Band Member cards. The structure of the Band Member cards is one element of an apparatus involving the specific nature of the Consequence cards, the layout of the pathways on the game board, and specific printed matter on the game board. These elements are interrelated in a functional way with the game apparatus. This interrelated functional relationship transforms the feeder paths to the stage into an alert system. When any player lands on a feeder path to the stage, this will alert all opposing players that the player is about to win the game unless the player is stopped. The opposing players must then utilize the Consequence cards in conjunction with the functional nature of the pathways where at each fork in

the pathways the Consequence spaces are staggered at different increments on each pathway making the design of the game board functional. The specific nature of the printed matter on the Consequence cards combined with the functional nature of the pathways and the printed matter on the pathways, transforms the pathways into a tool which enables the opposing players to utilize the pathways functionally to stop the player, on the feeder path to the stage, from winning the game; therefore, increasing the length of the game. The functional nature of Applicant's claimed invention and the functional nature of *Elrod's* invention are different. When the same Consequence card is inserted into the play of each game apparatus, each game apparatus will yield a different end result. For example: take a Consequence card from *Elrod* and insert it into each apparatus and examine the end result. *Elrod* discloses a Consequence card "Take an opponent's band member." This card is referring to the statuette of band members of *Elrod's* apparatus. The player will take a statuette from an opposing player. If the very same Consequence card is inserted into the Applicant's apparatus the player would take a Band Member card from an opposing player. The end result is that this will break up the opposing player's band, and will extend the length of the game. The reason why one can insert the exact same Consequence

card into both inventions and get two different end results is because the element's of Applicant's claimed invention are interrelated in a functional way which is absent from *E/rod*. The apparatus of Applicant's claimed invention is very complicated and intricate. Respectfully, I must have an oral hearing to fully explain all the details of the functioning apparatus, which will distinguish my invention from *E/rod*.

In the design of Applicant's game apparatus the Consequence cards can be utilized as a mechanism by the players to control the length of each game, simply by adding or subtracting specific Consequence cards.

Applicant's game apparatus contains Consequence cards, with specific printed matter which transforms the cards into a tool that the players can utilize to control the length of each game. This tool or "element" is absent in *E/rod*. Even though *E/rod* contains Consequence cards, in the design of *E/rod*, the Consequence cards cannot be utilized to control the length of each game. This fact alone suggests that there is a functional relationship within Applicant's claimed invention, which is absent from *E/rod*. In Applicant's claimed invention, if the players desire a short game, the players can remove the Consequence cards that enable the players to break up one another's band, and replace them with Consequence cards which award money to the players. This will create a game that will last

about a half hour. If the players would like to play a long game, the players can add Consequence cards that will enable players to break up one another's band. This will create a game that will last for many hours. This imparts functionality to the Consequence cards in relation to the length of the game, as well as to the object of the game. Because *E/rod* does not contain or utilize the apparatus which Applicant's claimed invention was designed around, there exists no such functional relationship within *E/rod* between the Consequence cards and the length of each game. In Applicant's claimed invention, every Consequence card will affect the length of each game played. In *E/rod*'s invention, the Consequence cards can not affect the length of each game. This evidence suggests that there is a fundamental difference in the elements of the two inventions, or a fundamental difference in the functional relationship between the elements of the two games. In this case, it is both. First, there is a functional relationship between the Consequence cards of Applicant's claimed invention: the layout of the pathways, the structure of a plurality of predetermined groups of Band Member cards (where the identity of the band member is shielded from the opposing players by the substrate) and the object of the game. This functional relationship is absent in *E/rod* and/or *Hunsgerger*. Second, *E/rod* does not contain the element of a Band

Equipment card, or the element of a Band Member card where the identity of the card is shielded from the opposing players by the substrate, and the Consequence cards of Applicant's claimed invention are not the same element as the Consequence cards of *E/rod*.

There is a functional relationship between the layout of the game board and the placement of the Consequence spaces which imparts functionality to the pathways. All of the before mentioned functional relationships of the Applicant's claimed invention are absent from *E/rod*. The functional relationship between all of the elements of Applicant's game apparatus and the game board cannot be ignored. The PTO has stripped away and ignored all functionality and functional relationships between all of the elements of Applicant's game apparatus, and has rejected all claims simply based on the fact that *E/rod* and Applicant's claimed invention both contain similar elements. This analysis only considers the elements of the two patents, and ignores all functional relationships between the elements of Applicant's claimed invention, as well as the functional relationship between the printed matter on the Band Member cards and the substrate. Certainly, in *Gulack* if the functional relationship between the printed matter and the substrate had been stripped away and ignored, the rejection would not have been reversed. *Gulack* filed a patent that stated the object of the

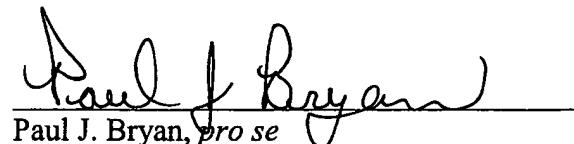
invention was to exploit certain arithmetic properties to create the semblance of magic or to educate with respect to intriguing aspects of number theory. *Gulack*'s invention does not utilize any magic, nor does it perform any magic tricks. *Gulack* claims to create the semblance of magic. The arithmetic properties of number theory are concrete and they never change or vary, because it is never wrong it seems like magic (The same holds true for Wittcoff's invention, which utilizes the same arithmetic properties of number theory.). The fact that Wittcoff chose a hat for his invention, and magicians have incorporated a "magic hat" in their acts for centuries, would provoke some thought as to if Wittcoff intended his invention to be a "magic hat." E. Wittcoff filed a patent in 1957 (U.S. Patent No. 2,796,680). Wittcoff discloses a hat with an endless band having information printed in areas around both the inside and outside of the band. The hat has an aperture at the base of the crown through which an area of the band is viewed. The band can be rotated to align any specific area of information with the aperture. When an inquiry on the outside of the band is aligned with the aperture, the corresponding answer is viewed through the aperture from the inside of the hat. Both *Gulack* and *Wittcoff* utilize the same apparatus, both have an endless band and both utilize the same mathematical principals to solve equations using number theory. The only

difference between *Gulack* and *Wittcoff* was that *Gulack* used “printed matter” in the form of a plurality of individual digits. The court ruled that the band served two functions: “It supports the sequence of digits and it presents the digits as an endless sequence with no discrete beginning or end.” For these two reasons, the digits had a functional relationship with the band, and the Examiner’s rejection was reversed. The printed matter of the Band Member cards of Applicant’s claimed invention can be compared to the digits of *Gulack*. The card supports the printed matter and presents the printed matter as part of a functioning structure. The substrate also presents the printed matter in a way which shields the identity of the band member and enables the printed matter to be traded and blind drawn between the players. The printed matter divides the substrates into the structure of the plurality of predetermined groups of collectible Band Member cards; this enables the cards to become a part of a functioning apparatus involving the Consequence cards in conjunction with the functional design of the pathways on the game board. The same principal of law applied to *Gulack* and *Wittcoff*, applies to Applicant’s claims in relation to *Elrod*’s claims. The differences between Applicant’s game apparatus and *Elrod*’s game apparatus cannot be ignored merely because those differences reside in the content of printed matter.

One very important point of fact is that *Gulack* and *Wittcoff* are the same kind of game. Both have the same elements, both have an endless band with numbers or “digits” which represent “numbers.” Both utilize the same apparatus. Both utilize the same endless band to solve mathematical equations, and both utilize the same mathematical principles of number theory to solve equations. *Elrod*’s game apparatus and Applicant’s game apparatus are completely different types of game apparatus. The *Elrod* game apparatus is designed for the sole purpose of each player to accumulate money, even the statuettes of band members are sold for money at the end of each game. In *Elrod*, the player with the most money at the end of the game is the winner. *Elrod* states that it is a “Method of playing a questions and answers game.” [A. 24 & 27.] *Elrod* and *Hunsberger* are both questions and answers board games, and Applicant’s game is designed around an apparatus which is completely absent from *Elrod* and/or *Hunsberger*. *Elrod* cannot and does not utilize the same apparatus that Applicant’s game is designed around. In most patents, it is not the elements of the invention which carry the patentable weights, but the functional relationship between the elements of the invention, or the functional nature of the invention itself which carries the patentable weight. In this case, the PTO has only considered the elements of the patent, and

has ignored all functionality. I hereby request an oral hearing to fully explain the functional relationship of Applicant's invention, which will distinguish Applicant's invention from *Elrod*.

Respectfully submitted this the 3rd day of February, 2009.



Paul J. Bryan, *pro se*
413 East Millbrook Road
Raleigh, NC 27609
(919) 258-5137

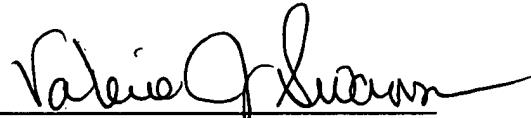
CERTIFICATE OF FILING AND SERVICE

I hereby certify that on this the 3rd day of February, 2009, I served an original of the foregoing **APPELLANT'S CORRECTED REPLY BRIEF** to the Clerk of Court for the United States Court of Appeals for the Federal Circuit via Federal Express addressed as follows:

Ms. Jan Horbaly
Clerk of Court
US Court of Appeals for the Federal Circuit
717 Madison Place, N.W.
Washington D. C. 20439

Further, I hereby certify that on this the 3RD day of February, 2009, I served one copy of the foregoing **APPELLANT'S CORRECTED REPLY BRIEF** to opposing counsel via Federal Express addressed as follows:

Raymond T. Chen
Office of the Solicitor, USPTO
Madison West Bldg. HC43A
Arlington, VA 22214



Valerie J. Swanson

FORM 19. Certificate of Compliance With Rule 32(a)

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION,
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS**

1. This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B) or FRAP 28.1(e).

The brief contains [5,727] words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii), or

The brief uses a monospaced typeface and contains [*state the number of*] lines of text, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) or FRAP 28.1(e) and the type style requirements of Federal Rule of Appellate Procedure 32(a)(6).

The brief has been prepared in a proportionally spaced typeface using [Microsoft Word 2003] in [size 14 Arial], or

The brief has been prepared in a monospaced typeface using [*state name and version of word processing program*] with [*size 14 Arial*].

(s) Paul J. Bryan

Paul J. Bryan

(Name of Attorney)

Pro se appellant

(State whether representing appellant, appellee, etc.)

February 3, 2009

(Date)

**This Page is Inserted by IFW Indexing and Scanning
Operations and is not part of the Official Record**

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:**

IMAGES ARE BEST AVAILABLE COPY.

As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.